



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/281,695	03/30/1999	JURGEN BRIESKORN	GR99P1337	7537

24131 7590 07/06/2004
LERNER AND GREENBERG, PA
P O BOX 2480
HOLLYWOOD, FL 33022-2480

EXAMINER

NGUYEN, HAI V

ART UNIT	PAPER NUMBER
----------	--------------

2142

21

DATE MAILED: 07/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

JUL 06 2004

Technology Center 2100

Application Number: 09/281,695
Filing Date: March 30, 1999
Appellant(s): BRIESKORN ET AL.

BRIESKORN ET AL.
For Appellant

MAILED

JUL 02 2004

Technology Center 2100

EXAMINER'S ANSWER

This is in response to the appeal brief filed 26 April 2004.

(1) -- Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

Art Unit: 2142

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 1-20 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,533,102	Robinson et al.	2-1996
US2001/0043608	Potter et al.	11-2001

Art Unit: 2142

6,163,532	Taguchi et al.	12-2000
6,449,260 B1	Sassin et al.	9-2002
6,052,461	Lam	4-2000

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102(b) that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 13-20 are rejected under 35 U.S.C. 102(b) as being anticipated by **Robinson et al patent no. 5,533,102.**

3. As to claim 1, Robinson teaches the invention as claimed, including a communications system, comprising:

a first communications terminal (*Fig. 4, the called party using phone 12*) to be connected, via a first network (*Fig. 4, PSTN*), to a second communications terminal (*Fig. 4, the caller using phone 54*) (*Fig. 4, computer 14 or phone 12 to be connected via PSTN and PSX, to phone 54*);

a remote computer (*Fig. 2, the Auto-Attendant system 200 or Figs. 1, 4, the call processor server 38*);

Art Unit: 2142

said first communications terminal (*the called party with phone 12*) having a central controller (*the called party API which is the PC 212 in Fig. 2 or the programmed PC 14 in Fig. 1 or 4*) transmitting status data relating to functional features of said first communications terminal to said remote computer via a second network (*the called party API allows the called party to send commands to the auto-attendant system 200 or the call processor system 38 to affect the flow of caller conversation, such as a change state command (col. 6, lines 25-34) (the state register object 214 stores the state change request and delivers it to the state controller 206 (col. 7, lines 1-6) via bi-directional link 72)*, said remote computer is programmed to automatically evaluate the status data and to generate an instruction sequence from the status data and to transmit the instruction sequence to said first communications terminal via the second network (*the link 72 forms an alternative bi-directional second communication channel between the PBX and the programmed personal computer 14 through the user's telephone 12, col. 8, lines 10 – 21*) (Robinson, the state controller 206 notifies the state registry object 214 of the new call received and each state transition for each call; the state controller also queries the state registry object 214 to see if the called party has requested a state change; Robinson, Fig. 4, item 40; col. 6, lines 55-60; Robinson also teaches that the personal computer 40 is programmed to cause the call processor system 38 to function as an auto-attendant and a voice mail system, col. 4, line 62 – col. 5, line 5; col. 8, lines 10-29) (Robinson, all of the functions in the API return a success code to indicate that the function succeeded or a failure code to indicate the function failed and the reason for the failure. Each of these codes has a defined meaning for

Art Unit: 2142

each function. For example, the change state command returns zero (0) to indicate the command was accepted by the auto-attendant system 200, one (1) to indicate that the command was rejected by the auto-attendant system 200 because the call has terminated (the caller hang up), or other values to indicate other reasons for the command being rejected by the auto-attendant system 200, or other reasons for failure of the function, such as the LAN communication being lost, col. 6, lines 35-47); and

said central controller employing the instruction sequence as a programs section and providing the functional features to said first communications terminal upon processing the program section (when the state registry object 214 receives notification of a call state change, it checks whether the called party has established a session to receive call notification; if so, it invokes the callback function to notify the called party of the call state change, using separate "client service thread" (col. 6, lines 61-67; col. 8, line 3 – col. 9, line 12); Robinson, the information upon which the programmed personal computer 14 operates in order to provide information concerning telephone calls to the user's extension telephone 12 is passed to the programmed personal computer 14 from the PBX 26, through the link 28, the extension telephone 12, and the bi-directional link 72. This information is used to produce displays such as the window shown in Fig. 3 (col. 8, lines 10-29; Fig. 5, col. 8, line 30 – col. 9, line 12)).

4. As to claim 13, Robinson teaches said central controller for reading keyboard codes of keys pressed from a keypad buffer (Robinson, col. 1, lines 55-64).

5. As to claim 14, Robinson teaches, wherein the status data contain key codes of keys pressed (Robinson, col. 2, lines 5-15).

Art Unit: 2142

6. As to claim 15, Robinson teaches, wherein said controller is programmed to generate from the status data instructions writing key codes into the keypad buffer (*Robinson, col. 1, lines 60-64*).

7. As to claim 16, Robinson teaches wherein said first communications terminal includes a visual display unit (*Robinson, Fig. 3*), and said remote computer is programmed to generate from the status data instructions which output data on said visual display unit (*Robinson, after the auto-attendant system 38 has handled the call from the caller, it will display appropriate information on the display 20 of the PC 14, for user to read, col. 7, lines 25-29*).

8. As to claim 17, Robinson teaches, wherein said remote computer is programmed to generate from the status data instructions for producing sound signals (*Robinson, col. 6, lines 2-24, a recording made of the caller's voice; col. 7, lines 55-60*).

9. As to claim 18, Robinson teaches, wherein the status data contain a telephone number of the second communications terminal calling said first communications terminal (*Robinson, col. 6, lines 2-24; the caller's phone number*).

10. As to claim 19, Robinson teaches, wherein the remote computer is programmed to establish a connection to said first communications terminal (*Robinson, the PC 14 and the call processor system 38 which includes the programmed personal computer 40 can communicate directly with each other using client-server or peer-to-peer protocol, col. 4, line 42 – col. 5, line 5*).

11. As to claim 20, Robinson teaches, wherein a data item identifying said first communications terminal is transmitted with the status data (*Robinson, commands from*

Art Unit: 2142

the called party application to the auto-attendant system include a pointer to a call handle, a value indicating the state the called party wishes to move the call to, and a pointer to a block of parameters with additional information about the state to be moved to, col. 6, lines 25-34).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Robinson** et al patent no. **5,533,102** in view of the well-known feature of using Internet protocol.

14. As to claims 2-4, Robinson teaches the invention substantially as discussed above; however, Robinson does not explicitly teach the Internet protocol.

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of Robinson with the well-known feature to use the Internet protocol because it would allow users to communicate each other (see patent no. **US2001/0043608 A1**, Fig. 2, node 38; patent no. **6,163,532**, Fig. 1, item 14).

Art Unit: 2142

15. Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Robinson et al** patent no. **5,533,102** in view of the well-known feature of using H.323 protocol.

16. As to claim 5, Robinson teaches the invention substantially as discussed above; however, Robinson does not explicitly teach the H.323 protocol.

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of Robinson with the well-known feature to use the H.323 protocol because it would allow the H.323 calls to be translated to CSTA protocol by using Bearer Control and Call Layers and passed on to the Business Application (see patent no. **US2001/0043608 A1**, Fig. 4, par. [0034]; see patent no. **6,449,260 B1**, Fig. 1, items 52, 56, 58).

17. As to claim 6, Robinson teaches a first communications controller controlling a communication with the second communications terminal (*Robinson*, Fig. 4, item 54; col. 8, lines 5-9).

18. As to claim 7, Robinson teaches, wherein said remote computer and said first communications terminal communicate in accordance with a CSTA protocol (*Robinson*, col. 5, lines 6-14).

19. As to claim 8, Robinson teaches, which further comprises a second communications controller controlling a communication between said first communications terminal and said remote computer (*Robinson*, optionally the called party sends the auto-attendant system commands to handle the call(s), and to "logout" or "terminating a session"; col. 1-6).

Art Unit: 2142

20. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Robinson et al** patent no. **5,533,102** in view of the well-known feature of using the Internet connection.

21. As to claim 9, Robinson teaches the invention substantially as discussed above; however, Robinson does not explicitly teach the Internet connection.

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of Robinson with the well-known feature to use the Internet connection because it would allow users to communicate each other (see patent no. **US2001/0043608 A1**, Fig. 2, node 38; see patent no. **6,449,260 B1**, Abstract)).

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Robinson et al** patent no. **5,533,102** as applied to claims 1-9 above, and further in view of **Lam** patent no. **6,052,461**.

24. As to claim 10, Robinson teaches the invention substantially as discussed above; however, Robinson does not explicitly teach a converter to converse the data to CSTA data.

Art Unit: 2142

Lam teaches the interface adapter to convert the data to CSTA formatted data (*Lam, col. 2, lines 25-31*).

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of Robinson and Lam to provide data converter because it would allow the computer to use the suitable protocol for communication with others (*Lam, col. 2, lines 25-31*).

25. As to claim 11, Robinson-Lam teaches, wherein the instruction sequence generated by the remote computer contains instructions defined by the CSTA protocol (*Robinson, col. 5, lines 6-14*).

26. As to claim 12, Robinson-Lam teaches, which further comprises a converter connected between the remote computer and said central controller, said converter converting CSTA instructions transmitted from the remote computer into control instructions for said central controller (*Lam, Interface Adapter 130; col. 2, lines 2-31*).

(11) Response to Argument

The Appellant argued in substance that:

Issue 1: Whether or not claims 1, 13-20 are anticipated by Robinson et al. under 35 U.S.C. 102(b). **Robinson** et al. does not teach "said first communications terminal having a central controller transmitting status data relating to functional features of said first communications terminal to said remote computer via a second network, said remote computer being programmed to automatically evaluate the status data and to generate an instruction sequence from the status data and to transmit the instruction sequence to said first communications terminal via the second network; and

Art Unit: 2142

said central controller employing the instruction sequence as a program section and providing the functional features to said first communications terminal upon processing the program section" in independent claim 1 of the instant application.

Robinson discloses that "said first communications terminal (*the called party with phone 12*) having a central controller (*the called party API which is the PC 212 in Fig. 2 or the programmed PC 14 in Fig. 1 or 4*) transmitting status data relating to functional features (*hold, re-route, accept call, none/other*) of said first communications terminal to said remote computer (*Fig. 2, item 200 or Fig. 4, item 40*) via a second network (*bi-directional link 72*) (*the called party API allows the called party to send commands to the auto-attendant system 200 or the call processor system 38 to affect the flow of caller conversation, such as a change state command (col. 6, lines 25-34)*) (*the state register object 214 stores the state change request and delivers it to the state controller 206 (col. 7, lines 1-6) via bi-directional link 72*)), said remote computer (*the auto answering system or the Auto-Attendant system*) is programmed to automatically evaluate the status data and to generate an instruction sequence (*continuing to hold, or rerouting to the substitute extension number, or taking a message, or hanging up*) from the status data and to transmit the instruction sequence to said first communications terminal via the second network (*Robinson discloses in Fig. 7 that the options and actions are taken if the called party requests the apparatus 10 to offer the caller the opportunity to hold (block 124, Fig. 5). In this case, the apparatus 10 plays the greeting (chosen by the called party) to the caller (block 164). Next, the auto answer system begins to periodically inquire whether the caller is willing to hold (block 166). This could*

Art Unit: 2142

be either a hold within the apparatus 10 or the PBX system 26. If the caller is no longer willing to continue to hold, the apparatus 10 plays a holding prompt to the caller (block 170). The apparatus 10 then inquires of the called party's line whether the called party has requested to be connected to the call (block 172). If not, the apparatus 10 informs the caller that the called party is still busy (block 174) and returns to block 166 to inquire whether the caller is still willing to hold. If the called party has requested to be connected to the call, the apparatus 10 routes the called party of the caller's call (block 176) and other functional features of reroute options and actions in Fig. 8, and of greeting actions of take a message in Fig. 9 (col. 9, line 40 col. 11, line 14); and

said central controller employing the instruction sequence as a program section and providing the functional features to said first communications terminal upon processing the program section (when the state registry object 214 receives notification of a call state change, it checks whether the called party has established a session to receive call notification; if so, it invokes the callback function to notify the called party of the call state change, using separate "client service thread" (col. 6, lines 61-67; col. 8, line 3 – col. 9, line 12); Robinson, the information upon which the programmed personal computer 14 operates in order to provide information concerning telephone calls to the user's extension telephone 12 is passed to the programmed personal computer 14 from the PBX 26, through the link 28, the extension telephone 12, and the bi-directional link 72. This information is used to produce displays such as the window shown in Fig. 3 (col. 8, lines 10-29; Fig. 5, col. 8, line 30 – col. 9, line 12)).

Art Unit: 2142

Refer to Appellant's Brief: Appellant argued on page 13 (paper # 20), that Robinson does not disclose "the functional features are made available in the first communications terminal by processing the instruction sequence as a program section".

In response to Appellant's argument, Robinson discloses that in Fig. 5, the functional features (hold, re-route, accept call) are made available to the called party by choosing the holding options & action, re-route options & action, select greeting, complete connection, cancel connection, or send to voice mail.

Refer to Appellant's Brief: Appellant argued on page 14 (paper # 20), that Robinson does not disclose "the status data relating to functional features of a communication terminal".

In response to Appellant's argument, Robinson discloses that *in Fig. 7, caller willing to hold? (block 166). If yes, playing holding prompt (block 170), otherwise, send to voice mail (block 168).*

Refer to Appellant's Brief: Appellant argued on page 14 (paper # 20), that Robinson does not disclose "a remote computer evaluating the status data and generating an instruction sequence to be executed by a controller of a communications terminal".

In response to Appellant's argument, Robinson discloses that *"In Fig. 7 that the options and actions are taken if the called party requests the apparatus 10 to offer the caller the opportunity to hold (block 124, Fig. 5). In this case, the apparatus 10 plays the greeting (chosen by the called party) to the caller (block 164). Next, the auto answer system begins to periodically inquire whether the caller is willing to hold (block 166).*

Art Unit: 2142

This could be either a hold within the apparatus 10 or the PBX system 26. If the caller is no longer willing to continue to hold, the apparatus 10 plays a holding prompt to the caller (block 170). The apparatus 10 then inquires of the called party's line whether the called party has requested to be connected to the call (block 172). If not, the apparatus 10 informs the caller that the called party is still busy (block 174) and returns to block 166 to inquire whether the caller is still willing to hold. If the called party has requested to be connected to the call, the apparatus 10 routes the called party of the caller's call (block 176) and other functional features of reroute options and actions in Fig. 8, and of greeting actions of take a message in Fig. 9 (col. 9, line 40 col. 11, line 14).

Art Unit: 2142

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

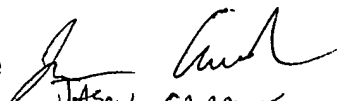
Hai V. Nguyen
Examiner
Art Unit 2142


Hai V. Nguyen
June 23, 2004

Conferees

Jack B. Harvey

Jason D. Cardone


JASON CARDONE
PRIMARY EXAMINER
AU: 2142


JACK B. HARVEY
SUPERVISORY PATENT EXAMINER

LERNER AND GREENBERG
POST OFFICE BOX 2480
HOLLYWOOD, FL 33022-2480